

Applicants : Ron S. Israeli, et al  
U.S. Serial No.: 08/403,903  
Filed : March 17, 1995  
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label. --

#### REMARKS

Claims 1, 6, 12, 13, 22, 23, 34, 35, 45, 47, 49-52, and 74-79 were pending in the subject application. Applicants have hereinabove canceled claims 1, 6, 12, 13, 22, 23, 34, 35, 45, 47, 49-52, and 74-79 and added new claims 90-99. Accordingly, claims 90-99 are under examination in the subject application.

Support for claims 90-99 may be found inter alia in the specification as follows: page 23, lines 4-35; and page 24, lines 11-19. Applicants maintain that the amendments to the claims do not constitute new matter. Accordingly, applicants respectfully request entry of claims 90 - 99.

In the February 5, 1997 Office Action, the Examiner asserted that Restriction under 35 U.S.C. 121 to one of the following inventions is required: I. Claims 1, 12, 13, 74-76 drawn to a nucleic acid encoding a prostate specific antigen; II. Claim 23 drawn to a ligand that binds to said antigen; III. Claim 22, drawn to a method of using the ligand to determine if said ligand binds to the antigen; IV. Claims 34 and 35, drawn to a antibody, directed to said antigen or a peptide of said antigen; V. Claim 45, drawn to a method of detection using said antibody and composition comprising said antibody and carrier (or radioisotope); VI. Claim 47, drawn to a transgenic mammal which comprises the nucleic acid molecule encoding said antigen; VII. Claim 49-52, and 77 drawn to a method of treatment using the nucleic acid encoding said antigen; VIII. Claims 78 and 79 drawn to a method of detection using primers that hybridize to said antigen.

The Examiner asserted that the inventions are distinct, each from the other because of the following reasons: a 371 case is

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considered to have unity of invention only when there is a technical relationship among those inventions involving one or more of the same or corresponding technical features. The Examiner asserted that the expression "special technical feature" means those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. The Examiner asserted that while the instant claims all involve the prostate specific antigen, it is clear from the PCT International Preliminary Examination Report, in particular Feng et al., that this feature does not define a contribution over the prior art.

The Examiner asserted that the inventions listed in Group I-VIII do not relate to a single inventive concept because they lack the same or corresponding technical features, since as stated above, the one special technical feature shared by all claims does not constitute a contribution over the prior art.

In response, without conceding the correctness of the Examiner's assertion, applicants have canceled claims 1, 6, 12, 13, 22, 23, 34, 35, 45, 47, 49-52, and 74-79 and filed new claims 90-99. The subject matter as defined by claims 90-99 is directed to a nucleic acid molecule of at least 15 nucleotides capable of specifically hybridizing with a nucleic acid molecule encoding the prostate specific membrane antigen.

Applicants note that claims 90-99 are contained in Group VIII, claims 78 and 79 and thus by canceling claims 1, 6, 12, 13, 22, 23, 34, 35, 45, 47, 49-52, and 74-79 and adding new claims 90-99 applicants are in effect electing Group VIII.

Applicants point out that the subject matter defined by claims 90-99 are connected and are not independent inventions. Further, applicants maintain that it would not be a serious burden on the Examiner to conduct a search for any prior art for the subject

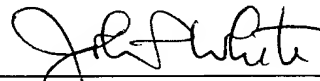
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matter now claimed.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

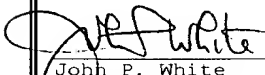
No fee, except for a fee of \$465.00 for the three-Month extension of time is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.



6/9/97

John P. White  
Registration No. 28,678

Date